

REMARKS/ARGUMENTS

Status of the Claims

Claims 1 and 35-37 are currently pending in the application. Claims 1 and 36 have been amended. No new matter has been added by the amendments. No claims have been added. No claims have been cancelled. Therefore, claims 1 and 35-37 are present for examination. Claims 1 and 36 are independent claims.

Prior to entry of this amendment, the application included claims 1 and 35-37. A non-final office action, mailed January 28, 2008, rejected claims 1 and 35-37 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,483,983 issued to Takahashi (“**Takahashi**”) in view of U.S. Patent No. 6,938,215 issued to Kobayashi (“**Kobayashi**”) and U.S. Patent No. 5,544,354 issued to May (“**May**”).

35 U.S.C. §103 Rejection, Takahashi in view of Kobayashi and May

Claims 1 and 35-37 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Takahashi in view of Kobayashi and May. Applicants respectfully request reconsideration of the rejection because the Examiner has failed to show a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, *the prior art reference (or references when combined) must teach or suggest all the claim limitations.* MPEP §2142, Original Eighth Edition, August, 2001, Latest Revision August 2006 (*emphasis added*).

The combination of Takahashi, Kobayashi and May does not describe all the limitations of the claims.

Claimed embodiments of the invention describe, in part, that a user-specified title is automatically played back if there is not any input from the user for a predetermined duration

of time. Therefore, a user can view and check moving pictures bay waiting for the automatic playback without pushing a select button.

Claim 1, and similarly claim 36 recite "the system control module, in response to receiving a user-specified title selection from the cursor button, is configured to control the decoder module to *play back automatically a motion picture of the user-specified title as a small frame if there is no button input for a select period of time.*" (emphasis provided). The Office action asserts that May teaches such a feature. Specifically, the Office action at page 6, ll. 5-12 asserts that "May teaches that [the] focus command 400...may be automatically invoked if the viewer does not provide another input, for a predetermined period of time, i.e., a timeout, see [May at] col. 15, lines 45-67." Applicants respectfully disagree with this assertion.

Applicants respectfully submit that May teaches away from playback of a *motion picture* of a user-specified title, as recited by claim 1. Specifically, May discloses that after invoking the command focus 400 "the content window will begin to display 403 a series of *previews* dependent on the currently focused cell." (see May at col. 15, ll. 51-53; emphasis provided). May further discloses that "if a record cell represents a movie, then the *preview* may contains selected portions from the film; *previews* of textual records may contain information identifying author, title, date, and a summary of the text. *Previews* of audio records may contain a selected portion of the recorded audio. A *preview* of a record cell informs the viewer of the record's data." (see May at col. 13, ll. 32-37; emphasis provided). Hence, according to May's description of a preview, May describes a preview as textual information and not a motion picture as in claim 1, and similarly claim 36. Therefore, May teaches away from playback of a *motion picture* of a user-specified title. Accordingly, Applicants respectfully submit that May teaches away from claims 1 and 36.

Additionally, Applicants submit that Takahashi and Kobayashi also fail to disclose any of the limitations discussed above. Since May, Takahashi and Kobayashi all fail to disclose the cited elements, the combination of May, Takahashi and Kobayashi as a whole also fails to make obvious the claims. Accordingly, for at least the reasons stated above, Applicants respectfully submit that claims 1 and 36 are patentable over May, Takahashi and Kobayashi. Furthermore, because claims 35 and 37 depend from independent claims 1 and 36, Applicants

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respectfully submit that claims 35 and 37 are also patentable over May, Takahashi and Kobayashi for at least the same reasons. As such, Applicants respectfully request that the rejection of claims 1 and 35-37 be withdrawn.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,

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